



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,177	04/26/2001	Shinichi Nishimura	2271/64894	9173

7590 09/21/2005

RICHARD F. JAWORSKI
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

LETT, THOMAS J

ART UNIT	PAPER NUMBER
----------	--------------

2626

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,177

Applicant(s)

NISHIMURA, SHINICHI

Examiner

Thomas J. Lett

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16, 21 and 22 is/are allowed.
- 6) ☐ Claim(s) 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/26/01</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claim 17-20 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

2. Claim 1-16, 21 and 22 are allowed.
3. The following is a statement of reasons for the indication of allowable subject matter: Claims 1, 11, and 21 are allowed for the reasons pointed out by Applicant's remarks (p13, p14, lines 1-10, and p14, lines 16-20). Claims 2-10, 12-16 and 22 are then inherently allowable for depending on an allowable base claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsuka et al (USPN 6,700,674 B1).

With respect to claim 17, Otsuka et al disclose a facsimile device (facsimile

Art Unit: 2626

apparatus 1A, col. 11, lines 32-41) that transmits image information to a destination, comprising:

an electronic-mail control unit (mail controller 35, col. 12, lines 22-31) used for transmitting the image information in an electronic-mail format to said destination through a computer network (via the LAN 22, col. 12, lines 37-39);

a real-time network control unit (mail controller 35, col. 14, lines 42-58 for G3 transmission in a real-time fashion) used for transmitting the image information to said destination while said facsimile device and said destination are connected on line through the computer network (via the LAN 22, col. 12, lines 37-39); and

a transmission specifying unit (CPU 11 executes communication control, col. 11, lines 42-46) specifying one of said electronic-mail control unit and said real-time network control unit as a communication control unit in accordance with a destination address of said destination (can specify a route of email or real-time based on the priority listed in EEPROM 14, col. 13, lines 48-53), wherein said facsimile device transmits the image information to said destination address by use of the communication control unit specified by said transmission specifying unit in a case in which said destination address is selected.

With respect to claim 18, Otsuka et al disclose a facsimile device that transmits image information to a destination, comprising:

a facsimile control unit (modem 16 performs facsimile transmissions through the public communications switched network 32 via the NCU 15, col. 12, lines 15-20) used

Art Unit: 2626

for transmitting the image information to said destination through a telephone line network by following a fixed facsimile transmission procedure;

an electronic-mail control unit (mail controller 35, col. 12, lines 22-31) used for transmitting the image information in an electronic-mail format to said destination through a computer network (via the LAN 22, col. 12, lines 37-39);

a real-time network control unit (mail controller 35, col. 14, lines 42-58 for G3 transmission in a real-time fashion) used for transmitting the image information to said destination while said facsimile device and said destination are connected on line through the computer network (via the LAN 22, col. 12, lines 37-39); and

a direct/memory transmission specifying unit (a route of email or real-time is specified based on the priority listed in EEPROM 14, col. 13, lines 48-53) specifying a transmission method in accordance with a destination address of said destination, for each destination, said transmission method indicating one of direct transmission and memory transmission, wherein said direct/memory transmission specifying unit can further specify usage of said electronic-mail control unit or said real-time network control unit for each transmission method, and said facsimile device transmits the image information to said destination by use of either said electronic-mail control unit or said real-time network control unit corresponding to said transmission method if said destination address is selected.

With respect to claim 19, Otsuka et al disclose a facsimile device as claimed in claim 18, wherein said facsimile device transmits the image information to said destination address, by use of said real-time network control unit if the transmission

Art Unit: 2626

method specified by said direct/memory transmission specifying unit is the direct transmission (mail controller 35, col. 14, lines 42-58 for G3 transmission in a real-time fashion), or said electronic-mail control unit if said transmission method is the memory transmission (mail controller 35 for email transmission, col. 12, lines 22-31).

With respect to claim 20, Otsuka et al disclose a method of selecting a transmission method for transmitting image information from a facsimile device to a destination, comprising the steps of:

specifying the transmission method, that is, one of an electronic-mail transmission method and a real-time transmission method, for each destination address used for transmitting the image information through a computer network (a method of email transmission or real-time (G3) transmission is specified based on the priority listed in EEPROM 14, col. 13, lines 48-53); and

transmitting the image information to a destination address through the computer network by use of the transmission method corresponding to said destination address if said destination address is specified as the destination (mail controller 35 can send directly scanned fax data through the computer network, col. 14, lines 42-58).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571)272-7464. The examiner can normally be reached on 7-3:30pm.

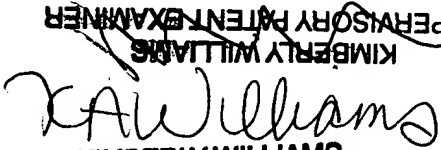
Art Unit: 2626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL

TJL


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER